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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/767,763

01/30/2004

Hidehiko Ogawa

P24508

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7055 7590 07/26/2007  
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EXAMINER

LEE, TOMMY D

ART UNIT

PAPER NUMBER

2625

NOTIFICATION DATE

DELIVERY MODE

07/26/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

# Office Action Summary

Application No.

10/767,763

Applicant(s)

OGAWA, HIDEHIKO

Examiner

Thomas D. Lee

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,8,9,11,13,14,16,18,20,22,24,26,28,30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,8,9,11,13,14,16,18,20,22,24,26,28,30 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office action is responsive to Applicant's RESPONSE UNDER 37 C.F.R. § 1.111, filed May 3, 2007. Claims 1, 3, 4, 6, 8, 9, 11, 13, 14, 16, 18, 20, 22, 24, 26, 28, 30 and 32 are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to the prior rejection of claims 1-33 on the ground of nonstatutory obviousness-type double patenting, as set forth on pages 3-6 of the Office action mailed March 6, 2007, have been considered but are moot in view of the new ground(s) of rejection. While Applicant's Terminal Disclaimer effectively removes U.S. Patent 7,095,524 from consideration, the claims have been amended in such a way that they are now rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 7,221,471, as set forth below.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 2625

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 3, 4, 6, 8, 9, 11, 13, 14, 16, 18, 20, 22, 24, 26, 28, 30 and 32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5-7, 9-11, 13, 15, 17, 19, 21, 23, 25, 27 and 29 of U.S. Patent No. 7,221,471 (Ogawa). Although the conflicting claims are not identical, they are not patentably distinct from each other because all but one feature of the claims in the application read on the limitations of the patent, and the one feature not recited in the patent claims would have been an obvious modification to one of ordinary skill in the art.

For example, claim 1 of the application, as amended, appears below. The differences between this claim and claim 1 of U.S. Patent 7,221,471 are reflected in bracketed portions corresponding to recitations that appear exclusively in the patent, and underlined portions corresponding to recitations that appear exclusively in the application.

**An image data communication apparatus connected to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, the image data communication apparatus comprising:**

**a scanner configured to scan the image data;**

a memory configured to store a default e-mail address [and an e-mail address of at least one user], the memory being within the image data communication apparatus;

a panel configured to [select the] input an e-mail address of [at least one] a user [stored in the memory other than the default e-mail address stored in the memory] into the image data communication apparatus, the panel including a start actuator; and

a controller configured to control the scanner to scan the image data and to convert the scanned image data into a format for e-mail transmission in response to operation of the start actuator, the controller being further configured to set the default e-mail address into the mail message of the e-mail to which the image data is attached when the e-mail address of the user is not [selected] input by the panel, the controller being further configured to set the e-mail address of the user [selected] input by the panel into the mail message of the e-mail to which the image data is attached when the e-mail address of the user is [selected] input by the panel, the e-mail address of the user being distinct from an e-mail address of the image data communication apparatus, whereby the e-mail address of the user set into the mail message of the e-mail can be utilized as a destination [for] of a reply to the e-mail, the reply being sent from the receiving apparatus, the reply being returned to the e-mail address of the user, and not being returned to e-mail address of the image data communication apparatus.

The only feature of application claim 1 not recited in patent claim 1 is the panel section in the application configured to input information regarding an identification of a user to the image data communication apparatus, as opposed to the panel section in the patent configured to select information regarding the identification of the user in a memory, which stores user identification information. It is well known in the art that a keypad is usable for both entering user information as well as for selecting user information previously stored in a memory. For example, it is well known in facsimile communications to store frequently-dialed fax numbers in a memory for one-touch dialing on a keypad, and using the same keypad for regular dialing. It would have been obvious to one of ordinary skill in the art that the panel section in the patent may be modified so as to enable a user to input identification information not previously stored in the memory in the same manner that a user inputs a destination fax number when the fax number is not stored in a memory for one-touch dialing.

By similar comparison of the remaining claims of the application and patent, it is clear that each of the remaining application claims 3, 4, 6, 8, 9, 11, 13, 14, 16, 18, 20, 22, 24, 26, 28, 30 and 32 either read on, or would have been an obvious modification of, corresponding patent claims 2, 3, 5-7, 9-11, 13, 15, 17, 19, 21, 23, 25, 27 and 29.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2625

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-7436. The examiner can normally be reached on Monday-Friday, 7:30-5:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Thomas D Lee  
Primary Examiner  
Technology Division 2625

tdl  
July 19, 2007